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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,711	08/01/2003	Dennis A. Carson	023070-124010US	2786
20350	7590	09/10/2007		
TOWNSEND AND TOWNSEND AND CREW, LLP			EXAMINER	
TWO EMBARCADERO CENTER			KWON, BRIAN YONG S	
EIGHTH FLOOR				
SAN FRANCISCO, CA 94111-3834			ART UNIT	PAPER NUMBER
			1614	
			MAIL DATE	DELIVERY MODE
			09/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/632,711

Applicant(s)

CARSON ET AL.

Examiner

Brian S. Kwon

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 July 0212 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 12 February 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-8, 14-17, 21-26, 35-38, 51-58 and 63.

Claim(s) withdrawn from consideration: 9-13, 18-20, 31-34 and 39-41.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☒ Other: PTO-892 attached.

BRIAN-YONG S. KWON
PRIMARY EXAMINER



Continuation of 11. does NOT place the application in condition for allowance because: At the time of the invention was made it was well known that IMPDH inhibitor is useful as anti-cancer agent as well as immunosuppressive chemotherapeutic agent for the treatment of cancer (i.e., lymphoma, leukemia and other forms of cancers such as cancers of head and neck, lung cancer, mediastinal tumors etc...) alone or in combination with other known anti-tumor or cancer agent (e.g., cis-platin, actinomycin D, doxorubicin, vincristine, vinblastine, etoposide, amasacrine, mitoxantrone, teniplaside, taxol, colchicine, cyclosporin A, phenothiazines, thioxatheres, methotrexate, tellunomide, cyclophosphamide, etc...), wherein said anti-tumor or cancer agent is administered prior to concurrently with or following the administration of the IMPDH inhibitor composition; and wherein mycophenolate mofetil, tiazofurin and mizoribine are disclosed as other suitable immunosuppressant having IMPDH inhibiting activity (see USP 5807876, see entire documents, especially Abstract, column 2, lines 31-56, column 3, lines 22-30 and 35-37, column 16, lines 22-27, column 17 lines 61-65; USP 5380879, see entire documents especially, abstract, column 2, lines 6-7, column 69, lines 11-32, column 71, line 62 through column 72, line 9, column 72, lines 29-32; USP 6624184, abstract, column 30, lines 41-43). As evidenced by the prior art references, several chemotherapy drugs are routinely combined (common rationale for combination chemotherapy is to use drugs that work on different parts of the cancer cell's life cycle, thereby increasing the likelihood that more cancer cells will be killed. When drugs with different toxicities are combined, each drug can be used as its optimal dose, helping avoid intolerable side effects).

The cited references in combination make clear that each of active ingredients has been individually used for the treatment of cancer. It is obvious to combine two compositions each of which is taught by prior art to be useful for same purpose; idea of combining them flows logically from their having been individually taught in the prior art. The combination of active ingredient with the same character is merely the additive effect of each individual component. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).